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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,114	11/25/2003	Michael Z. Hoemann	SPV-048.02	4865

25181 7590 02/15/2006

FOLEY HOAG, LLP  
PATENT GROUP, WORLD TRADE CENTER WEST  
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BOSTON, MA 02110

EXAMINER
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DESAI, RITA J

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/722,114

Applicant(s)

HOEMANN, MICHAEL Z.

Examiner

Rita J. Desai

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 92-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 92-100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

Claims 1-92-100 are pending.

Restriction:-

In paper mailed 7/26/04, examiner did a restriction and applicants responded electing group I, without traverse.

The elected group I was as follows.

- I. Claim I in part, drawn to a compound of formula A wherein R1 is an aryl, R2 is ROalkyl or (R)2N-alkyl, R (S)-alkyl, (R)2Ncycloalkyl, (R)2N cycloalkyl or RS-cycloalkyl, R3 and R4 are H, alkyl or F or -OR, ( R is a non hetero ring R5 is a phenyl or a thiophene classified in class 546 and various subclasses.

In paper mailed 11/2004 examiner cited art and applicants amended the R1 to be a six-membered aromatic ring without any hetero atoms. R5 was amended to include substituted phenyl.

Claims 92 and its dependent claims were not amended to the elected group. R5 still recites carbocyclic aryl group optionally substituted.

Applicants are required to amend the claims to the restricted group.

In their response mailed 12/1/2005 applicants deleted the some of the non-elected subject matter and have also amended the claims to overcome some of the art rejection.

Applicants claims are broad . a preliminary search gives numerous iterations see below

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100.0% PROCESSED            497 ITERATIONS            50 ANSWERS  
INCOMPLETE SEARCH (SYSTEM LIMIT EXCEEDED)  
SEARCH TIME: 00.00.01

FULL FILE PROJECTIONS:    ONLINE    \*\*COMPLETE\*\*  
                                     BATCH    \*\*COMPLETE\*\*  
PROJECTED ITERATIONS:            8603 TO    11277

and hence new grounds of rejection follows.

The Rejection of claims 1 and 92 over DeGraw et al 1967 has been withdrawn since applicants have amended the claims and deleted the R being an alky-N group.

The rejection of claims 1 and 92 over Rehse et al DN 91:168231 has also been withdrawn partially since applicants have amended the claims to delete the (R)2Nalkyl.

However the 102 rejection of claims 1 and 92 over Rehse et al 1986 DN 106:18327 has been changed to a 103 since applicants have just changed the "n" from 0-2 to 0 and 1.

A difference of one -CH<sub>2</sub> -, make a compound a homolog and homologs are considered to be prima facie obvious variants. Compounds that differ in just one methylene group are considered homologs and are generally considered not patentable in the absence of unexpected results. A person of skill in the art would be motivated to prepare the homologs with slight variation in substitution because of close structural relationship.(see In re Ruddy 121 USPQ 427.).

### **New Ground of Rejection**

#### ***Claim Rejections - 35 USC § 102***

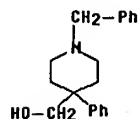
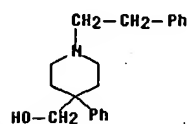
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 92 are rejected under 35 U.S.C. 102(b) as being anticipated by English

Abstract DN 94:57952 Yamato Masatoshi et al.

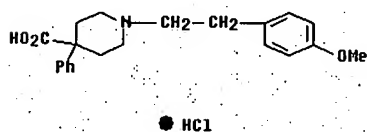
The reference discloses the compound RN # 590383-36-2 and 63080-12-6

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Claims 1 and 92-100 are rejected under 35 USC 102(b) as being anticipated by English Abstract DN 54:7351 GB 815926 and US 2966491.

The reference discloses the compounds of the formula

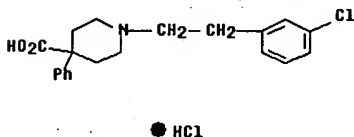


Isonipecotic acid, 1-(p-methoxyphenethyl)-4-phenyl-, ethyl ester 855291-79-1,

Claims 1 and 92-100 are rejected under 35 USC 102(b) as being anticipated by English

Abstract DN 54:39146, GB 817357

The reference discloses



Isonipecotic acid, 1-(m-chlorophenethyl)-4-phenyl-, hydrochloride.

*Conclusion*

The claims 1, 92-100 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rita J. Desai  
Primary Examiner  
Art Unit 1625

R.D.  
February 9, 2006

*RJ Desai*  
*2/9/06*